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09/824,034	04/03/2001	Koichi Hatakeyama	ND-384US	8743

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EXAMINER

ROSEN, NICHOLAS D

ART UNIT PAPER NUMBER

3625

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/824,034

Applicant(s)

HATAKEYAMA, KOICHI

Examiner

Nicholas D. Rosen

Art Unit

3625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

Claims 1-7 have been examined.

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it is more than 150 words long. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: On page 11, line 9, "the user is in its home" should be "the user is in his home", or "the user is in his or her home", or some variation, since people are not normally referred to by neuter pronouns.

Appropriate correction is required.

### ***Claim Objections***

Claims 1-3 are objected to because of the following informalities: In the twenty-second through twenty-fifth lines of claim 1, there appears to be a grammatical error. The download terminal presumably has means for reading out "that one of the titles . . . corresponds to the identification information," so the word "which" in the twenty-fourth line should be deleted. It is not necessary or correct to say "that one of the titles . . . which corresponds to the identification information." Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oakley (Canadian Published Patent Application 2,225,190) in view of official notice. As per claim 1, Oakley discloses an online distribution system, comprising: a search server (page 5, lines 16-30; page 10, lines 7-14); a data distribution server (page 2, line 27, through page 3, line 13); and a download terminal connected to said data distribution server (page 5, lines 16-30). Oakley does not expressly disclose a personal terminal, distinct from the download terminal, to which said search server is connectable, but such a terminal is held to be inherent, as necessary to access the Internet Web Site (page 10, lines 7-14). Oakley does not expressly disclose that the download terminal is

connected to the search server through the data distribution server, but official notice is taken that it is well known to connect to Internet Web Sites, and thus to the servers on which they are available, through the servers of ISP's, LAN's, WAN's, or other business, etc., servers. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the download terminal be connected to the search server through the data distribution server, for the stated advantage of enabling customers' pre-chosen track lists to be recalled, and (after customer confirmation) recorded.

Oakley discloses (by inherency) that said search server includes a database for storing a plurality of songs or other works for distribution information (page 10, lines 7-17). Oakley does not expressly disclose that this search server includes title search means for searching the titles stored in the database, but official notice is taken that it is well known to identify and search for musical and other works by their titles. Oakley's disclosure of recalling pre-chosen track lists at the download terminal implies that subscription and identification information must be stored and transmitted by some means from the search server and/or personal terminal to the download terminal. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the search server include title search means for searching the titles stored in the database, and subscription information storage means for storing the title searched out by the title search means, for the obvious advantage of enabling customers to identify desired musical works by title.

Oakley discloses a data distribution server including distribution information storage means for storing the distribution information (page 2, line 27, through page 3, line 13). Oakley discloses that the download terminal includes identification information acquisition means for acquiring identification information inputted from the outside (page 10, lines 7-14), first readout means for reading out, based on identification information acquired by said identification information acquisition means, that one of the titles stored in said subscription information storage means of said search server corresponds to the identification information (page 10, lines 7-14), second readout means for reading out the distribution information corresponding to the information read out by the first readout means from said distribution information storage means of said data distribution server, and recording means for recording the distribution information read out by said second readout means onto a recording medium (page 10, lines 7-14; page 2, line 23, through page 3, line 2).

As per claim 2, Oakley discloses that said download terminal further includes settlement means for performing a settlement in regard to the transmission of the distribution information for said personal terminal (page 2, line 27, through page 3, line 2).

As per claim 3, Oakley discloses a cache server in which part of the distribution information stored in said distribution information storage means of said data distribution server is stored in advance, and wherein said download terminal acquires, when the distribution information of the title corresponding to the identification information stored in said subscription information means of said search server is stored in said cache

server, the distributed information from said cache server, but acquires, when the distribution information is not stored in said cache server, the distribution information from said distribution information storage means of said data distribution server (page 3, lines 8-13; page 5, lines 16-30; page 11, lines 21-27).

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oakley (Canadian Published Patent Application 2,225,190) in view of Fritsch (U.S. Patent 6,247,130) and official notice. As per claim 4, Oakley discloses an online distribution system, comprising: a search server (page 5, lines 16-30; page 10, lines 7-14); a data distribution server (page 2, line 27, through page 3, line 13); and a personal terminal connected to said search server (page 10, lines 7-17), the personal terminal as such being inherent, as necessary to access the disclosed Internet Web Site. Oakley does not expressly disclose that the personal terminal is connected to the data distribution server through said search server, but does disclose that the Web site allows potential customers to browse and search the repertoire, listen to sound bites, save their selections, and, when the customers visit a kiosk connected to the data distribution server, get their pre-chosen track lists recalled (page 10, lines 7-14), implying that the Web site/search server is in contact with the data distribution server. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the personal terminal be connected to the data distribution server through said search server, for the obvious

advantage of avoiding the expense and difficulty of maintaining two libraries of the same songs, sound bites, etc.

Oakley discloses (by inherency) that said search server includes a database for storing a plurality of songs or other works for distribution information (page 10, lines 7-17). Oakley does not expressly disclose that this search server includes title search means for searching the titles stored in the database, but official notice is taken that it is well known to identify and search for musical and other works by their titles. Oakley's disclosure of recalling pre-chosen track lists at the download terminal implies that subscription and identification information must be stored and transmitted by some means from the search server and/or personal terminal to the download terminal (public kiosk, in Oakley's terminology). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the search server include title search means for searching the titles stored in the database, and subscription information storage information for storing the title searched out by the title search means, for the obvious advantage of enabling customers to identify desired musical works by title.

Oakley discloses that said data distribution server includes distribution information storage means for storing the distribution information (page 2, line 27, through page 3, line 13). Oakley discloses that the download terminal includes identification information acquisition means for acquiring identification information stored in the subscription information storage means of said search server, and distribution information means for reading out the distribution information corresponding to said



information, and, by implication, transmission means for transmitting the distribution information to a personal terminal (page 10, lines 7-14). It is arguable whether the public kiosk disclosed by Oakley can be considered "the personal terminal," but Fritsch teaches transmitting distribution information to a user's personal terminal (Abstract; column 2, line 64, through column 3, line 9). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transmit the distribution information to said personal terminal, for the obvious advantage of enabling a potential customer to make purchases from his personal terminal.

As per claim 5, Oakley discloses a settlement means for performing a settlement in regard to the transmission of the distribution information for a personal terminal (page 2, line 27, through page 3, line 2). Fritsch teaches a settlement means for performing a settlement in regard to the transmission of the distribution information for a personal terminal distinct from a public kiosk (Abstract; column 2, line 64, through column 3, line 9; column 6, lines 14-48). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the data distribution server to further include a settlement means for performing a settlement in regard to the transmission of the distribution information for said personal terminal, for the stated advantage of obtaining payment for the music or other digital goods sold to customers.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oakley (Canadian Published Patent Application 2,225,190) in view of official notice. Oakley

discloses an online distribution method for an online distribution system wherein a download terminal is connected to a data distribution server (page 2, line 23, through page 3, line 22; page 5, lines 16-30) and a search server is connected to a personal terminal (page 10, lines 7-14) (by inherency, since such a terminal would have to be connected to a search server to access the disclosed Web site). Oakley does not expressly disclose that the download terminal is connected to the search server through the data distribution server, but Oakley's disclosure of the user obtaining information generated or selected at the Web site through the public kiosk/download terminal (page 10, lines 7-14), which is connected to the data distribution server (page 2, line 23, through page 3, line 22; page 5, lines 16-30), implies it.

Oakley discloses (by inherency) that said search server includes a database for storing a plurality of songs or other works for distribution information (page 10, lines 7-17). Oakley does not expressly disclose that this search server stores a plurality of titles in the database, and searches the titles, but official notice is taken that it is well known to identify and search for musical and other works by their titles. Oakley's disclosure of recalling pre-chosen track lists at the download terminal implies that subscription and identification information must be stored and transmitted by some means from the search server and/or personal terminal to the download terminal. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the search server include title search means for searching the titles stored in the database, and subscription information storage means for storing the title searched out by the title search means,

for the obvious advantage of enabling customers to identify desired musical works by title.

Oakley discloses that said data distribution server stores distribution information in distribution information storage means (page 2, line 27, through page 3, line 13).

Oakley discloses that the download terminal acquires identification information inputted from the outside, and reads out musical works corresponding to the identification information stored as the subscription information in said search server, reading out the distribution information corresponding to the identification information from the information storage means of said data distribution server, and recording the read out distribution information onto a recording medium (page 10, lines 7-14; page 2, line 23, through page 3, line 2).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oakley (Canadian Published Patent Application 2,225,190) in view of Fritsch (U.S. Patent 6,247,130) and official notice. Oakley discloses an online distribution method for an online distribution system wherein a personal terminal is connected to a search server (page 10, lines 7-17), the personal terminal being as such being inherent, as necessary to access the disclosed Internet Web Site. Oakley does not expressly disclose that the personal terminal is connected to the data distribution server through the search server, but does disclose that the Web site allows potential customers to browse and search the repertoire, listen to sound bites, save their selections, and, when the customers visit a kiosk connected to the data distribution server, get their pre-chosen track lists recalled

(page 10, lines 7-14), implying that the Web site/search server is in contact with the data distribution server. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the personal terminal be connected to the data distribution server through the search server, for the obvious advantage of avoiding the expense and difficulty of maintaining two libraries of the same songs, sound bites, etc.

Oakley discloses (by inherency) that said search server includes a database for storing a plurality of songs or other works for distribution information (page 10, lines 7-17). Oakley does not expressly disclose that this search server stores a plurality of titles in the database, and searches the titles, but official notice is taken that it is well known to identify and search for musical and other works by their titles. Oakley's disclosure of recalling pre-chosen track lists at the download terminal implies that subscription and identification information must be stored and transmitted by some means from the search server and/or personal terminal to the download terminal. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the search server include title search means for searching the titles stored in the database, and subscription information storage means for storing the title searched out by the title search means, for the obvious advantage of enabling customers to identify desired musical works by title.

Oakley discloses that said data distribution server stores the distribution information into distribution information storage means for (page 2, line 27, through

page 3, line 13), reads out the distribution information corresponding to information transmitted from the search server from the distribution information storage means, and transmits the read out distribution information to a personal terminal (page 10, lines 7-14). It is arguable whether the public kiosk disclosed by Oakley can be considered "said personal terminal," but Fritsch teaches transmitting distribution information to a user's personal terminal (Abstract; column 2, line 64, through column 3, line 9). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transmit the distribution information to said personal terminal, for the obvious advantage of enabling a potential customer to make purchases from his personal terminal.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tsevdos et al. (U.S. Patent 5,734,719) disclose a digital information accessing, delivery, and production system. Peterson (U.S. Patent 5,740,134) discloses a musical CD creation unit. Kaplan (U.S. Patent 5,963,916) discloses a network apparatus and method for preview of music products and compilation of market data. Kim et al. (U.S. Patent 6,330,490) disclose a data vending machine system and method thereof. Stern (U.S. Patent 6,366,914) discloses an audiovisual content distribution system. Negishi et al. (U.S. Patent 6,504,089) disclose a system for and method of searching music data, and recording medium for use therewith. Stern (U.S. Patent 6,553,404) discloses a digital system. Spagna et al. (U.S.

Patent 6,587,837) disclose a method for delivering electronic content from an online store.

Quarendon et al. (U.S. Patent Application Publication 2002/0023028) disclose retailing audio files in a fuel dispensing environment. Zhang et al. (U.S. Patent Application Publication 2002/0073098) disclose a methodology and system for searching music over a computer network based on melody and rhythm input. Kupka et al. (U.S. Patent Application Publication 2003/0221113) disclose a system for keying protected electronic data to particular media to prevent unauthorized copying using a compound key.

Brown ("Oracle, IBM Foray into New Markets") discloses distributing music over networks to kiosks in retail sites. Goodman ("IBM, Blockbuster Pushing Ahead") discloses having consumers order music, movies, or video games from kiosks, and have CD's created to order. The anonymous article, "IBM Updates Digital Library," discloses distributing music. The anonymous article, "MP3.com," discloses enabling consumers to search and download music.

Examiner has also obtained translations of the Japanese articles submitted in an IDS by Applicant, and makes these of record in the case.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. (Wynn Coggins is

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currently on assignment elsewhere in the Patent Office; the examiner's acting supervisor, Jeffrey Smith, can be reached at 703-308-3588.) The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Nicholas D. Rosen*  
**NICHOLAS D. ROSEN**  
**PRIMARY EXAMINER**

April 18, 2004